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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kazuki Matsui

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STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

SHAAWAT, MUSSA A

ART UNIT

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3627

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/955,049	Applicant(s) MATSUI ET AL.	
	Examiner Mussa A. Shaawat	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 and 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, and 20-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is in response to the amendment filed on February 02, 2007. Claims 1, 3-4, and 13-15 have been cancelled. Claim 2 has been amended. Claims 5-12, and 16-19 have been withdrawn. Claim 2 and 20 has been amended. Claim 21 has been newly added. Claims 2 and 20-21 are pending examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 2 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burge et al. US Patent No. (6,014,638) in view of Vatanen US Patent No. (6,237,093) and further in view of Welsh et al US Patent No. (6,757,691).

Burge et al. disclose an information presentation device Fig.1 in which a user terminal on a network that retrieves products or services comprising:

Accepting means (electronic shopping manager 84) for accepting a selection of a product or service that is included in said products or services that were retrieved based on the search parameters designated by the user (col. 5 line 56 raw data is collected by retrieving the specific products selected by the shopper) ; and parameter storage means (read as database 18) for storing said search parameters for the selected product or service as a candidate for purchase (col.7 lines 1-38...information regarding products and services retrieved from the merchant

database 22 which information includes navigational inputs text and mouse clicks entered while navigating for a "selected product/service"; and user identification information that identifies said user terminal (user identifier (ID) col. 4 identifies user and is deemed the obvious variant of the an inputted ID.

Notwithstanding, Vatanen discloses tying a user profile to a unique identifying address of a terminal device to identify the user. It would have been obvious to one of ordinary skill in the art to modify Burge et al. to use the terminal ID of the user, the motivation being the elimination of the sign-in step of Burge et al.

4. Neither Burge et al. or Vatanen disclose "user reference request accepting means for accepting user reference requests from first group of computer terminals on said network parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals, and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal, information setting means for receiving from said provider terminal the designation of user identification information included in said first user identification information provided to said provider terminal, and product information settings for said designated user identification information; product information storage means for storing said designated user identification information, said first product, and the product information that was set; and information presentation means for receiving a purchase candidate reference request from a designated user terminal identified by said

designated user identification information, extracting from said parameter storage means candidates for purchase that correspond to said designated user identification information, extracting said product information set for said first product that is included in said candidates for purchase from said product information storage means, and providing the extracted candidates for purchase and said product information to said designated user terminal”.

However, Welsh et al. does disclose user request accepting means for accepting user reference requests from first group of computer terminals on said network (predictive content system 700 and expert 1206 accepts by monitoring reference requests e.g. click stream decisions); Welsh et al. further disclose user reference request parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals (PID associates a user with a subset of content categories, content manager matches content choices with the PID see col. 13), and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal (based on this association, content system 700 presents a selection of content choices to the user col. 8, 62 et seq.) Welsh et al. further disclose information setting means (PID database 1104 col. 12 line 39) for receiving from said provider terminal the designation of user identification information included in said first user identification information provided to said provider terminal, and product information settings for said designated user identification

information (PID obviously includes settings of product information in order to be mapped to see col. 8 line 52); product information storage means for storing said designated user identification information (read as the PIDI data base which also receives the PID data where I indexes a profile), and presentation means (read also as the content system 700 which presents a selection of content choices to the user) for receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information. Regarding the extracting device portion, the identifier PIDI is referenced to a product information set and the user reads it on the extraction functions and these users identified by the suffix I are or can be presented as a group given the old and notorious use of a sorting function in computers. It would be obvious to one of ordinary skill in the art to modify the system of Burge et al. with the grouping feature of Welsh et al. as described above, the motivation being the ability to categorized groups of users or people who like a certain product for ease in mass marketing.

5. As per claim 20-21, the limitations of claims 20-21 contain similar limitations as in claim 2; therefore they are rejected based on the same rationale.

Response to Arguments

6. Applicant's arguments have been fully considered but are not persuasive. In Particular applicant argues:

A) The cited art, alone or in combination, does not teach a configuration where a product provider receives the user's navigational choices or a list of products in which the user is interested from a user.

In response to **A)** the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Welsh et al discloses user request accepting means for accepting user reference requests from first group of computer terminals on said network (predictive content system 700 and expert 1206 accepts by monitoring reference requests e.g. click stream decisions); Welsh et al. further disclose user reference request parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals (PID associates a user with a subset of content categories, content manager matches content choices with the PID see col. 13), and presentation means (read also as the content system 700 which presents a selection of content choices to the user) for receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information regarding the *extracting device portion*, the identifier PIDI is referenced to a product information set and the user reads it on the extraction functions and these users identified by the suffix I are or can be presented as a group given the old and notorious use of sorting function in computers. Therefore Burge et al in view of Vatanen and in further view of Welsh et al., still meet the scope of the limitations as currently claimed.

B) Applicant contends that there is no motivation to combine Burge in view of Vatanen, and further in view of Welsh.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be extremely advantageous to incorporate the teachings of Vatanen into the disclosure of Burge et al., to use the terminal ID of the user, the motivation being the elimination of sign-in step of Burge et al. Also it would be advantageous to incorporate the teachings of Welsh et al into the disclosure of Burge et al in view of Vatanen, the motivation being the ability to categorize groups of users or people who like a certain product for ease in mass marketing. Therefore, in view of the above evidence, the combination of Burge in view of Vatanen, and further in view of Welsh still meet the scope of the limitations as currently claimed.

Furthermore, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5: 30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat
Patent Examiner
September 6, 2007

 9/13/07
F. RYAN ZEENDER
PRIMARY EXAMINER